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Tiziano Panara

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EXAMINER

MACASIANO, MARILYN G

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/523,237	<b>Applicant(s)</b> PANARA, TIZIANO	
	<b>Examiner</b> MARILYN MACASIANO	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-10,12-15 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,12-15 and 18-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Remarks***

1. In response to communications filed on August 11, 2009, claims 1-6, 8, 9, 12 and 13 are amended and added claim 27. The currently pending claims considered below are claims 1-6, 8-10, 12-15 and 18- 27.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 11, 2009 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 1-6, 8-10, 12-15 and 18-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Rakavy et al. (U.S. Patent No. 5,913,040).

With respect to claims 1, 4 and 8, Rakavy et al. discloses a computer-based method of delivering auxiliary content comprising the steps of:

receiving over a network a request from a client terminal for an item of the auxiliary content, each item of the auxiliary content having an associated broadcast space comprising a respective time slot (col. 3, lines 4-43 and col. 7- 8, lines 51-3, fig. 4; col. 3, lines 15-33, col. 9, lines 1-7, fig. 4; col. 7-8, lines 51-3 and col.15, lines 28-42, fig. 10) the time slot associated with each said auxiliary content item defining a time frame for the delivery of the associated auxiliary content (i.e. advertisement is displayed during idle time as a screen saver, the screen saver subsystem tracks user interaction with the system and when the screen saver subsystem detects that the system has been idle, for example, when there has been no user interaction with the computer for a preconfigured time, it activates the advertisements display manager which will select an advertisement and display it) (col.3 lines 27-33; col. 7-8 lines 51-3; col. 9 lines 42-49 and col. 12 lines 61-65); and

selecting one of the items in accordance with a correlation between the broadcast spaces and a time instant of issuance of the request from a client terminal for the auxiliary content and a networked computer accessed by the client terminal ( i.e. the actual list of advertisement categories will be provided by the advertising system server, time periods during which sound only advertisement are to be played, time periods and types of foreground activities during which advertisements and feedback information

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may be transmitted) (col. 2-3, lines 66-14, col. 3, lines 52-63, col. 7, lines 51-55, col. 9, lines 35-49 and col. 14-15, lines 60-27).

With respect to claims 2, 5 and 9, Rakavy et al. discloses the method according to claim 4, wherein the broadcast space is segregated into network addresses, the request for auxiliary content includes an address of the networked computer, and the content selection step comprises selecting the auxiliary content in accordance with a correlation between the broadcast space, and a address of the accessed web site (col. 3, lines 8-43 and col. 5, lines 54-65, fig. 2).

With respect to claims 3, 6 and 10, Rakavy et al. discloses the method according to claim 19, wherein the client terminal has a configuration including at least one of a preferred language and a client jurisdiction, the broadcast space is further segregated into advertisement language and advertisement jurisdiction, and the selection step comprises selecting the auxiliary content in accordance with a correlation between the broadcast space and the client configuration (col. 5 - 6, lines 66-3, fig. 2 and col. 7-8, lines 63-3).

With respect to claim 12, Rakavy et al. discloses an auxiliary content delivery server comprising:

a content database of records each defining an item of auxiliary content, and a broadcast space for delivery of the associated auxiliary content item, the broadcast space being segregated into time slots (col. 3, lines 4-43 and col. 7- 8, lines 51-3, fig. 4; col. 3, lines 15-33, col. 9, lines 1-7, fig. 4; col. 7-8, lines 51-3 and col.15, lines 28-42, fig. 10) the time slot associated with each said auxiliary content item defining a time frame

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for the delivery of the associated auxiliary content (i.e. advertisement is displayed during idle time as a screen saver, the screen saver subsystem tracks user interaction with the system and when the screen saver subsystem detects that the system has been idle, for example, when there has been no user interaction with the computer for a preconfigured time, it activates the advertisements display manager which will select an advertisement and display it) (col.3 lines 27-33; col. 7-8 lines 51-3; col. 9 lines 42-49 and col. 12 lines 61-65);

content selection means in communication with the content database for selecting one of the items in accordance with a correlation between the broadcast spaces and a time instant of issuance of a request from a client terminal for the auxiliary content and a web page accessed by the client terminal (col. 2-3, lines 66-14, col. 3, lines 52-63, col. 7, lines 51-55, col. 9, lines 47-49 and col. 14-15, lines 60-27).

receiving means for receiving over a communications network the client terminal request for auxiliary content (col. 3, lines 4-26 and col. 9, lines 17-20); (col. 7, lines 45-61);

delivery means in communication with the content selection means for facilitating a download of the selected content to the client terminal over the network (col. 7, lines 45-61, fig. 4); and

response data processing means for processing response data received from the client terminal in response to the download auxiliary content (col. 5, lines 45-53, fig. 2, col. 7, lines 51-55, col. 9, lines 47-49 and col. 14-15, lines 60-27).

With respect to claim 13, Rakavy et al. discloses the auxiliary content delivery server according to claim 12, wherein the broadcast space is segregated into network addresses, the request for auxiliary content includes an address of the accessed web page, and the content selection means is configured to select the auxiliary content in accordance with a correlation between the broadcast space, and a network address of the accessed web page (col. 3, lines 8-43 and col. 5, lines 54-65, fig. 2).

With respect to claim 14, Rakavy et al. discloses the auxiliary content delivery server according to claim 21, wherein the client terminal has a configuration including at least one of a preferred language and a client jurisdiction, the broadcast space is further segregated into advertisement language and advertisement jurisdiction, and the content selection means is configured to select the auxiliary content in accordance with a correlation between the broadcast space and the client configuration (col. 5 - 6, lines 66-3, fig. 2 and col. 7-8, lines 63-3).

With respect to claim 15, Rakavy et al. discloses the auxiliary content delivery server according to Claim 12, wherein the response data processing means is configured to maintain statistics associated with the effectiveness of the download auxiliary content based on the received response data (col. 5, lines 54-65, fig. 2).

With respect to claim 18, Rakavy further teaches wherein the request for auxiliary content includes an indication of the time instant of the issuance of the request from the client terminal, and the content selection means is configured to select the auxiliary content in accordance with a correlation between the broadcast space, and the

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indication of the time instant of issuance of the request (col. 7, lines 51-55, col. 9, lines 47-49 and col. 14-15, lines 60-27).

With respect to claims 19-21, Rakavy further teaches wherein the request for auxiliary content includes an indication of the time instant of the issuance of the request from the client terminal, and the selection step comprises selecting the auxiliary content in accordance with a correlation between the broadcast space, and the indication of the time instant of issuance of the request (col. 3, lines 4-43 and col. 7- 8,lines 51-3, fig. 4; col. 3, lines 15-33, col. 9, lines 1-7, fig. 4; col. 7-8,lines 51-3 and col.15,lines 28-42, fig. 10).

With respect to claim 22, Rakavy further teaches wherein the response data comprises one of a number of times the downloaded auxiliary content was viewed, a duration the downloaded auxiliary content was viewed, a number of users who viewed the selected auxiliary content, and the time slots during which the selected auxiliary content was viewed.

With respect to claim 23, Rakavy et al. further teaches wherein the response data identifies the network address of the accessed web site (i.e. internet address are used for communicating on the network with which to communicate) (col. 3, lines 9-43, col. 5, lines 8-30; lines 54-65 and col.6, lines 9-20).

With respect to claim 24, Rakavy further teaches wherein the delivery means is configured to provide the client terminal with a network location of the selected one auxiliary content item (i.e. a third party may supply a location of a user or advertiser) (col. 9, lines 8-22).



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With respect to claims 25 and 27, Rakavy et al. further teaches facilitating a download of the selected one auxiliary content item to the client terminal (i.e. downloading and presenting individual advertisements and other informational messages from a network to a local computer) (col. 2-3 Lines 60-26, col. 5, lines 32-65, col. 6 lines 21-30 and col. 11 lines 31-44); and

receiving from the client terminal response data in response to the downloaded auxiliary content (i.e. the system monitors the user's interaction with the advertisements and produces data on information gathered) (col. 3, lines 44-63, col. 14-15, lines 60-27).

With respect to claim 26, Rakavy further teaches further comprising generating a report based on the received response data (i.e. the system monitors the user's interaction with the advertisements and produces data on information gathered) (col. 3, lines 44-63, col. 14-15, lines 60-27).

### ***Response to Arguments***

4. Applicant's arguments filed 08/11/2009 have been fully considered but they are not persuasive.

5. The Applicant argues in reference to amended claims 1, 4, 8 and 12 that Rakavy et al. does not disclose the time slot associated with each said auxiliary content item defining a time frame for the delivery of the associated auxiliary content. The Examiner notes that Rakavy teaches an advertisement is displayed during idle time as a screen

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saver, the screen saver subsystem tracks user interaction with the system and when the screen saver subsystem detects that the system has been idle, for example, when there has been no user interaction with the computer for a preconfigured time, it activates the advertisements display manager which will select an advertisement and display it) (col.3 lines 27-33; col. 7-8 lines 51-3; col. 9 lines 42-49 and col. 12 lines 61-65). Therefore, the rejection of amended claims 1, 4, 8 and 12 are maintained.

6. The Applicant argues in reference to amended claims 1, 4, 8 and 12 that Rakavy et al. does not disclose the display of the advertisements based on the time instant of issuance of a request from the local computer for the auxiliary content, the local computer downloading the advertisement from the advertising system server based on any particular time information, but instead downloads the advertisement in the background, during periods of low network utilization. The Examiner notes that Rakavy et al. discloses a Polite Agent Technology currently used to download advertisement in the background during low line utilization can be **modified** to receive **current data**, such as news and stock quotes (col. 14-15, lines 60-27). Furthermore, an alternate embodiments and modification to the Polite Agent Technology, it is by basic algorithm, able to download and display advertisement at the instant the user requests the content. Finally, the actual list of advertisement categories will be provided by the advertising system server, time periods during which sound only advertisement are to be played, time periods and types of foreground activities during which advertisements and feedback information may be transmitted) (col. 2-3, lines 66-14, col. 3, lines 52-63, col.

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7, lines 51-55, col. 9, lines 35-49 and col. 14-15, lines 60-27). The rejection of amended claims 1, 4, 8 and 12 under 102(b) is therefore maintained.

7. The Applicant argues that Rakavy et al. does not disclose selecting the auxiliary content based on a web site accessed by the client terminal. The Examiner notes that in several paragraphs, Rakavy et al. teaches a local computer initiating communication with a predetermined advertising system server, to include the World Wide Internet and commercial on-line services such as America Online, available from America Online In., CompuServe, available from H & R Block Inc., Prodigy, available from Prodigy Services, Microsoft Network, available from Microsoft Corp., as well as other services from a variety of companies such as AT&T Corporation and MCI Communications Corp. The predetermined advertising system server will select the next advertisement to be downloaded and transmit the network address of the advertising system server storing the advertisement. The local computer uses the transmitted network address to request the selected advertisement from the appropriate advertising system server (col. 4-5, lines 46-65). Furthermore, in col. 9-10 lines 55-8, Rakavy teaches the job manager on the network server matches the user preferences and configuration data against the category information for the available advertisements. Advertisements matching the user's high priority categories and platform capabilities are selected for downloading. The rejection of amended claims 1, 4, 8 and 12 under 102(b) is therefore maintained.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Himmel et al. (U.S. Patent No. 6,275,854) Method and apparatus for detecting actual viewing of electronic advertising.

b. Walker et al. (U.S. Pub. No. 2001/0018771) System and method for supplying supplemental information for video programs.

c. Katiyar et al. (U.S. Patent No. 7,366,682) System, method, and code for providing promotions in a network environment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARILYN MACASIANO whose telephone number is (571)270-5205. The examiner can normally be reached on 5/4/9 8:00-5:30 Mon.-Thur. 8:00-4:30 Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Weinhardt can be reached on (571)272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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11/08/2009